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*Admitted only in Maryland
*Admitted only in Virginia
•Practice Limited to
Federal Agencies

June 24, 2004

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Art Unit 1623

Mail Stop RCE

Re: U.S. Allowed Utility Patent Application
Application No. 09/058,350; Filed April 10, 1998
For: **RNA Isolation Reagent and Methods**
Inventor: Domenica Simms
Our Ref: 0942.3840001/RWE/CJW

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Fee Transmittal (Form PTO/SB/17);
2. Request to Withdraw from Issue under 37 C.F.R. § 1.313(a) For Consideration of a Request for Continued Examination;
3. Request For Continued Examination (RCE) Transmittal (Form PTO/SB/30);
4. Fifth Supplemental Information Disclosure Statement;
5. Form PTO-1449 (5 sheets) and accompanying (15) references;
6. Return postcard; and
7. PTO-2038 Credit Card Payment Form for \$770.00 to cover the fee for filing a Request for Continued Examination.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
June 24, 2004
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Christopher J. Walsh
Agent for Applicant
Registration No. 55,709

CJW/dab
280066_1.DOC
Enclosures



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Simms, Domenica

Appl. No.: 09/058,350

Filed: April 10, 1998

For: **RNA Isolation Reagent and
Methods**

Confirmation No.: 7377

Art Unit: 1623

Examiner: Owens, Jr., Howard V.

Atty. Docket: 0942.3840001/RWE/CJW

Fifth Supplemental Information Disclosure Statement

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying Form PTO-1449 are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. A copy of each document is also provided.

The numbering on this Fifth Supplemental Information Disclosure Statement is a continuation of the numbering in Applicant's Fourth Supplemental Information Disclosure Statement filed November 6, 2003, in connection with the above-captioned application.

The Examiner is referred to the following list of related, co-pending patent applications:

U.S. Patent Application No. 09/478,456, filed January 6, 2000, inventor Blakesley, R.W., and listed on the accompanying PTO-1449 forms as document AS6;

U.S. Patent Application No. 10/738,221, filed December 18, 2003, inventor Jesse, J., *et al.*, and listed on the accompanying PTO-1449 forms as document AT6;

U.S. Patent Application No. 10/073,260, filed February 13, 2002, inventor Simms, D., *et al.*, and listed on the accompanying PTO-1449 forms as document AR7;

U.S. Patent Application No. 10/318,399, filed December 13, 2002, inventor Lin, J.-J., and listed on the accompanying PTO-1449 forms as document AS7; and

U.S. Patent Application No. 10/046,667, filed January 16, 2002, inventor Domenica Simms, and listed on the accompanying PTO-1449 forms as document AT7.

The Examiner's attention is also directed to the prosecution from co-pending U.S. Patent Application No. 10/046,667, filed January 16, 2002, inventor Domenica Simms, and listed on the accompanying PTO-1449 forms as document AT7. The submitted prosecution includes Office Communications and Applicant's amended claim sets submitted in response to the Office Communications. The prosecution is cited herein as documents AR8 through AS8.

The identification of these U.S. Patent Applications, and any corresponding prosecution, is not to be construed as a waiver of secrecy as to these applications, or the

corresponding prosecution, now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications, the corresponding prosecution and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicant has listed publication dates on the attached PTO-1449 based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicant reserves the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

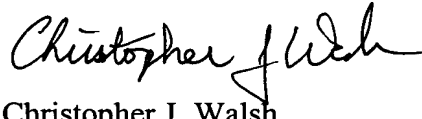
This Fifth Supplemental Information Disclosure Statement is being filed before the mailing date of a first Office Action after the filing of a request for continued examination under 37 C.F.R. § 1.114. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed PTO-1449, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

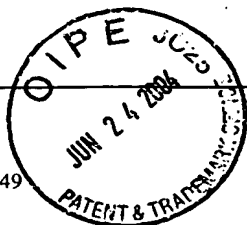
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Christopher J. Walsh
Agent for Applicants
Registration No. 55,709

Date: June 24, 2004

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280376v1



FORM PTO-1449

**FOURTH SUPPLEMENTAL
INFORMATION DISCLOSURE STATEMENT**

ATTY. DOCKET NO.
0942.3840001/RWE/CJW

APPLICATION NO.
09/058,350

APPLICANT
Simms, D.

FILING DATE
April 10, 1998

GROUP
1623

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB- CLASS	FILING DATE
	AA						
	AB						
	AC						
	AD1	US 5,585,264	12/1996	Babluk et al.			
	AE1	US 5,155,018	12/1992	Gillespie et al.			
	AF						
	AG						
	AH						
	AI						
	AJ						
	AK						

FOREIGN PATENT DOCUMENTS

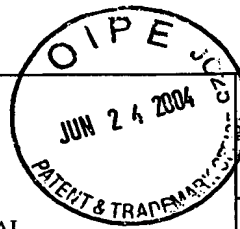
EXAMINER INITIAL		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUB- CLASS	TRANSLATION
	AL						Yes No
	AM						Yes No
	AN1	WO 96/34949 A1	11/07/1996	WIPO			Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR		
	AS		
	AT	4	Bahloul, M. and Burkard, G., "An Improved Method for the Isolation of Total RNA from Spruce Tissues," <i>Plant Mol. Biol. Reporter</i> 11:212-215, Mary Ann Liebert, Inc (1993)
EXAMINER		DATE CONSIDERED	

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449

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INFORMATION DISCLOSURE STATEMENTATTY. DOCKET NO.
0942.3840001/RWE/CJWAPPLICATION NO.
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Simms, D.FILING DATE
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	AA						
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	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

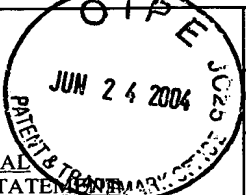
OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>5</u>	Chang, S., <i>et al.</i> , "A Simple and Efficient Method for Isolating RNA from Pine Trees," <i>Plant Mol. Biol. Reporter</i> 11:113-116, Mary Ann Liebert, Inc (1993)
	AS	<u>5</u>	Dong, J. G., <i>et al.</i> , "Cloning of a cDNA encoding 1-aminocyclopropane-1-carboxylate synthase and expression of its mRNA in ripening apple fruit," <i>Planta</i> 185:38-45, Springer-Verlag (1991).
	AT	<u>5</u>	Graham, G.C., "A Method for Extraction of Total RNA from <i>Pinus radiata</i> and Other Conifers," <i>Plant Mol. Biol. Reporter</i> 11:32-37, Mary Ann Liebert, Inc (1993)

EXAMINER

DATE CONSIDERED

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

FORM PTO-1449 FOURTH SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT		ATTY. DOCKET NO. 0942.3840001/RWE/CJW	APPLICATION NO. 09/058,350
		APPLICANT Simms, D.	
		FILING DATE April 10, 1998	GROUP 1623

U.S. PATENT DOCUMENTS

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	AA						
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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	<u>6</u>	Schneiderbauer, A., <i>et al.</i> , "Isolation of Functional RNA from Plant Tissues Rich in Phenolic Compounds," <i>Anal. Biochem.</i> 197:91-95, Academic Press, Inc. (1991).
	AS	<u>6</u>	Pending Non-Provisional U.S. Patent Application No. 09/478,456, Blakesley, R.W., filed January 6, 2000.
	AT	<u>6</u>	Pending Non-Provisional U.S. Patent Application No. 10/738,221, Jesse, J., <i>et al.</i> , filed December 18, 2003.
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	APPLICANT Simms, D.	
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	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	7	Pending Non-Provisional U.S. Patent Application No. 10/073,260, Simms, D., <i>et al.</i> , filed February 13, 2002.
	AS	7	Pending Non-Provisional U.S. Patent Application No. 10/318,399, Lin, J.-J., filed December 13, 2002.
	AT	7	Pending Non-Provisional U.S. Patent Application No. 10/046,667, Simms, D., filed January 16, 2002.
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	AL						Yes No
	AM						Yes No
	AN						Yes No
	AO						Yes No
	AP						Yes No

OTHER (Including Author, Title, Date, Pertinent Pages, etc.)

	AR	g	Prats, F.C., Office Communication for United States Patent Application No. 10/046,667, 9 pages, United States Patent and Trademark Office (mailed August 25, 2003).
	AS	g	Esmond, R.W., Applicant's Amendments to the Claims for United States Patent Application No. 10/046,667, 5 pages, "Amendment and Reply Under 37 C.F.R. § 1.111" (filed February 25, 2004).
	AT		
EXAMINER		DATE CONSIDERED	

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